

Rabbani et al.

Serial No.: 08/978,637

Filed : November 25, 1997

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And Preliminary Amendment -- January 6, 2003]

### **REMARKS**

Claim 317 is added to recite a specific embodiment. Accordingly, claims 245-280, 282-284, and 286-317 are pending in the above-referenced application. Claims 247, 278 and 302 have been amended to more distinctly claim that which Applicants regard as their invention. Specifically, in claims 247, 278 and 302, "bacterium" has been removed. Claim 250 has been amended to change the dependency to claim 245.

### **Restriction Requirement**

It is asserted in the Office Action that this application contains claims directed to the following patentably distinct species of the claimed invention:

- (1) claim 246: prokaryotic or eukaryotic;
- (2) claims 247, 278, 302: a nucleic acid or nucleic acid construct or nucleic acid conjugate, a virus or viral fragment, viroid, a phage, plasmid, plasmid vector, bacterium, or bacterial fragment, or a specific combination;
- (3) claim 248: single-stranded, double-stranded or partially double-stranded;
- (4) claims 249-250, 303: DNA, RNA, nucleic acid analogs, or a specific combination;
- (5) claims 251, 268, 279: DNA, RNA, DNA-RNA hybrid, DNA-RNA chimera, or a specific combination;
- (6) claim 253: promoter, initiator, terminator, intron, cellular localization element, or a specific combination;
- (7) claim 254: signal processing element is located in the primary nucleic acid component, secondary nucleic acid component, nucleic acid product, tertiary nucleic acid component, or a specific combination;

(8) claims 256, 273, 312: antisense RNA, antisense DNA, ribozyme, protein binding nucleic acid sequence, or a specific combination;

(9) claim 257: viral assembly or viral replication;

(10) claim 259: viral vector, phage vector, plasmid vector, or a specific combination thereof;

(11) claim 261: eukaryotic or prokaryotic;

(12) claim 267: cytoplasmic or nuclear localization signaling sequence;

(13) claims 271, 296: U1, U2, or both;

(14) claims 275, 276, 277, 292, 293, 294, 304: RNA or DNA;

(15) claim 283: viral vector, phage vector, plasmid vector or a specific combination;

(16) claim 289: organism, organ, tissue, culture, or a specific combination;

(17) claim 300: part of the same polynucleotide sequence or part of different polynucleotide sequences;

(18) claim 305: more than one promoter, more than one initiator, both;

(19) claim 306: different promoters, different initiators, or both;

(20) claim 307: complementary to a viral RNA, complementary to a cellular RNA, bind to a viral protein, bind to a cellular protein, or a specific combination;

(21) claim 309: viral protein comprises localizing protein, viral protein comprises decoy protein, cellular protein comprises localizing protein, cellular protein comprises decoy protein;

(22) claim 310 nuclear or cytoplasmic; and

(23) claim 311: viral assembly or viral replication.

Applicants respectfully traverse the rejection. Although 35 U.S.C. §121 provides that restriction may be required to one of two or more independent and distinct inventions, 37 C.F.R. §1.141 provides that a reasonable number of species

may still be claimed in one application if the other conditions of the rule are met. Applicants note that in groups (1), (9), (11), (12), (14), (17), (22), (23) there are only two species recited; in groups (3), (13), (18) or (19) there are only three species recited; and in groups (4), (10) and (21), there are only four species recited. It would certainly not be unduly burdensome to search such a small number of species.

Furthermore, the species in each of the specified groups are related to each other, thereby reducing the search burden. Specifically, the claims in groups (1) and (11) are directed to cells; the claims in groups (2)-(4) are directed to the primary nucleic acid component; the claims in group (5) are directed to the secondary nucleic acid component; the claims in groups (6) and (7) are directed to a signal processing sequence; the claims in groups (8), (9), (14), (19), (20)-(23) are directed to a nucleic acid product; the claims in groups (12) and (13) are directed to localizing entities; the claims in groups (10) and (15) are directed to vectors; and the claims in groups (16) are directed to biological systems. Applicants respectfully request, therefore, that the rejection be reconsidered and withdrawn.

In order to be completely responsive, however, Applicants have made elections in each of the groups. These are summarized in the table below. Applicants note that claims readable on the species elected are also listed in the table.

Group	Claims	Species Elected
(1)	245, 246	Eukaryotic
(2)	245, 247, 278, 302	Nucleic Acid
(3)	245, 248	Single-stranded
(4)	245, 249-250,	RNA

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	303	
(5)	245, 251, 268, 279, 317	Combination of the foregoing <sup>1</sup>
(6)	245, 252, 253	Intron
(7)	245, 252, 254	Signal processing element is located in the tertiary nucleic acid component
(8)	245, 256	Antisense RNA
(9)	245, 256, 257	Viral assembly
(10)	245, 258, 259	Viral vector
(11)	245, 260, 261	Eukaryotic
(12)	265, 267	Nuclear localization sequence
(13)	265, 267, 268, 269, 270, 271, 290, 294, 295, 296	U1
(14)	265, 273, 275, 276, 277, 290, 292, 293, 294, 299, 303, 304	Antisense RNA
(15)	265, 282, 283	Vector
(16)	265, 284, 288, 289	Culture
(17)	299, 300	Part of the same polynucleotide sequence
(18)	299, 305	More than one promoter
(19)	299, 306	Different promoters
(20)	299, 307	Complementary to viral RNA
(21)	299, 307, 308, 309	Viral protein comprises localizing protein
(22)	299, 307, 308, 309, 310	Nuclear
(23)	299, 307, 308, 309, 311	Viral assembly

<sup>1</sup> See new claim 317, which recites that the secondary nucleic acid component is DNA and the tertiary component is RNA

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**Submission of Formal Patent Drawings**

Applicants and their attorney are in the process of preparing formal patent drawings. As soon as that process has been completed, new formal drawings will be submitted. It is expected that the submission will be made well before the present one month extension will have expired.

**Submission of Art-Related Documents**

An Information Disclosure Statement is also being prepared. It is expected that an IDS will be submitted before the expiration of the present one-month extension period.

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### **SUMMARY AND CONCLUSIONS**

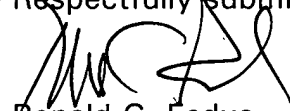
Claims 245-280, 282-284, and 286-316 are presented for further examination in the above-referenced application. Claim 317 has been added.

Claims 247, 250, 278 and 302 have been amended.

The claim fee for adding new claim 317 is \$9 based upon the small entity fee [1 claim X \$9 = \$9]. Small entity status was previously established and is still applicable. The Patent and Trademark Office is hereby authorized to charge the requisite \$9 claim fee to Deposit Account No. 05-1135. This response is also accompanied by a Request For Extension Of Time (1 Month) and authorization for the fee therefor. No other fee or fees are believed due in connection with this paper. In the event that any fee or fees are due for this paper, however, the Patent and Trademark Office is hereby authorized to charge any such fee or fees to Deposit Account No. 05-1135, or to credit any overpayment thereto.

If a telephone conversation would further the prosecution of the present application, Applicants' undersigned attorney requests that he be contacted at the number provided below.

Respectfully submitted,



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**AMENDED CLAIMS-MARKED UP VERSION**

247. (Amended) The composition of claim 245, wherein said primary nucleic acid component is selected from a nucleic acid , a nucleic acid construct , a nucleic acid conjugate, a virus, a viral fragment, a viral vector, a viroid, a phage, a phage, a plasmid, a plasmid vector, ~~a bacterium~~ and a bacterial fragment, or a combination of the foregoing.

250. (Amended) The composition of claim ~~245~~249, wherein said DNA, RNA or both are modified.

278. (Amended) The composition of claim 265, wherein said nucleic acid component is selected from a nucleic acid, a nucleic acid construct, a nucleic acid conjugate, a virus, a viral fragment, a viral vector, a viroid, a phage, a phage, a plasmid, a plasmid vector, ~~a bacterium~~ and a bacterial fragment, or a combination of the foregoing.

302. (Amended) The nucleic acid component of claim 299, wherein said component is derived or selected from a nucleic acid, a nucleic acid construct, a nucleic acid conjugate, a virus, a viral fragment, a viral vector, a viroid, a phage, a phage, a plasmid, a plasmid vector, ~~a bacterium~~ and a bacterial fragment, or a combination of the foregoing.

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